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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/563,793	08/04/2006	Paul C. Kocher	2147.028US1	3031

31665 7590 12/09/2010
PATENT DEPARTMENT
ROVI CORPORATION
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EXAMINER

WRIGHT, BRYAN F

ART UNIT	PAPER NUMBER
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2431

MAIL DATE	DELIVERY MODE
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12/09/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/563,793	Applicant(s) KOCHER ET AL.	
	Examiner BRYAN WRIGHT	Art Unit 2431	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 September 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 30-53 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 30-53 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>9/22/2010</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is in response to amendment filed 9/22/2010. Claims 30, 35, 38, 40, 46, and 51-53 are presently amended. Claims 30-53 are pending.

Specification

2. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: Applicant's claims 35-37 and 46-50 are directed towards an "optical medium" however applicant's specification does not provide a proper antecedent basis.

3. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: Applicant's claim 52 is directed towards a "machine readable medium" however applicant's specification does not provide a proper antecedent basis.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-

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type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Omum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969). A timely filed terminal disclaimer in compliance with 37 CFR 1.321 (c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement. Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 30, 35 and 53 are provisionally rejected on the ground of nonstatutory obviousness- type double patenting as being unpatentable over copending application 10/614765 claims 2, 12 and 16 hereinafter of Kocher (2) in view of Herzberg et al. (EP 0717337 and Herzberg hereinafter).

Claims 2, 12 and 16 of Kocher (2) teaches receiving data including the digital content, first data processing instructions, the first data processing instructions

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corresponding to the digital content, and executing the first data processing instructions by using the computer language interpreter, the first data processing instructions configuring the computer language interpreter to: obtain a cryptographic value of the second data processing instructions; determine an authenticity of the second data processing instructions by using the cryptographic value; based on the authenticity, performing a first operation selected from a first group consisting of: inhibiting playback of at least a portion of the digital content, and enabling the access by the computer language interpreter to the memory of the playback device, the access being performed by the computer language interpreter during execution of the second data processing instructions.

Kocher (2) does not expressly teach a second data processing instructions such that a second data processing instructions, when executed by a computer language interpreter of the playback device, configuring the computer language interpreter to request an access to a memory of the playback device. However these features are well known in the art and would have been an obvious modification of the system disclosed by Kocher (2) as introduced by secondary reference, Herzberg. Herzberg, discloses a real addressing mode or a protected addressing mode such that each mode provides an addressing scheme for accessing different areas of the microprocessor's memory. In this instance, mode is a logic state invoked by the program to execute access to memory. Additionally, Herzberg teaches a memory controller which includes logic for mapping addresses to and from the CPU to particular areas of RAM. In this instance the CPU is considered to be equivalent to applicant's interpreter [col. 5, lines

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55-58]). It is important to note that per applicant's original disclosure paragraph 137, a "second data processing instruction" is content code or program code. Therefore, given the teachings of Kocher's (2) ability to receive and transmit content data, a person having ordinary skill in the art at the time of the invention would have recognized the desirability and advantage of modifying Kocher (2) to enhance playback device memory access by employing the well known feature of programming selectively accessing memory as described above by Herzberg. This is a Provisional Double Patenting Rejection.

Response to Arguments

Examiner Remarks – Specification Objection

The Examiner maintains the Specification Objection in view of applicant's non-compliance.

Examiner Remarks –Double Patenting Rejection

The Examiner maintains the Double Patenting Rejection. The Double Patenting Rejection will be withdrawn upon receipt of a formal Terminal Disclaimer.

Examiner Remarks – 35 U.S.C 101

The Examiner withdraws rejections made under 35 U.S.C. 101 in view of applicant's claim amendments.

Examiner Remarks – 35 U.S.C 103(a)

Applicant's arguments and claim amendments filed 9/22/2010 have been fully considered. The Examiner finds applicant's amendments sufficient to overcome the cited prior art of Herzberg, Suzuki and Kocher. The 103 rejections are therefore withdrawn. The Examiner notes that upon receipt of a formal Terminal Disclaimer and formal correction of the specification antecedent basis issues as described above, the application will be in a condition for allowance.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BRYAN WRIGHT whose telephone number is (571)270-3826. The examiner can normally be reached on 8:30 am - 5:30 pm Monday -Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Korzuch can be reached on (571) 272-7589. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/BRYAN WRIGHT/
Examiner, Art Unit 2431

/William R. Korzuch/
Supervisory Patent Examiner, Art Unit 2431